

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte THOMAS SAI YING KO

Appeal No. 2006-2223
Application No. 09/717,088

ON BRIEF

Before ADAMS, GREEN and LEOVITZ, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 22-32, 34, 37, and 38. Claim 33 stands objected to as being dependent upon a rejected base claim, and therefore is not before us on appeal. Answer, page 2. The examiner has indicated that the only remaining claims, claims 35 and 36 are allowable. Id.

Claim 22 is illustrative of the subject matter on appeal and is reproduced below:

22. A non-aerosol sprayable skin patch composition consisting essentially of:
 - (a) 0.01% to 10% W/W of at least one water-soluble physiologically active ingredient;
 - (b) 1% to 50% w/w of at least one substantially water insoluble film forming agent selected from the group consisting of acrylic acid, polyacrylic acid, polybutylmethacrylate, polymethacrylic acid, ascorbyl palmitate, carbomer, cellulose acetate phthalate, hydroxyethyl cellulose, hydroxypropyl cellulose, hydroxypropyl

methylecellulose, ethyl cellulose, hydroxypropyl methylecellulose phthalate, hypomellose phthalate, crospovidone, cetyl alcohol, poloaxmer, polyethylene glycol, polyvinyl acetate, polyvinyl acetate phthalate, polyvinyl alcohol, and povidone;

- (c) 0.1% to 20% w/w of at least one film plasticizer agent; and
- (d) 30% to 90% w/w of at least one volatile organic solvent, wherein said composition forms a flexible, porous and physiologically compatible skin patch when sprayed onto skin and is allowed to dry, wherein said patch disintegrates progressively over a 24-48 hour time period.

The references relied upon by the examiner are:

Gleichenhangen et al. (Gleichenhangen)	3,987,000	Oct. 19, 1976
Tipton et al. (Tipton)	5,632,727	May 27, 1997
Modak et al. (Modak)	5,708,023	Jan. 13, 1998

GROUND OF REJECTION

Claims 22-32, 34, 37, and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Gleichenhangen, Tipton and Modak.

We reverse.

DISCUSSION

According to the examiner (Answer, page 3), Gleichenhangen teaches sprayable polymer compositions that comprise (a) a water-soluble physiologically active ingredient (antiseptic or bacteriostatic substances¹); (b) a film forming agent (acrylic acid²); (c) a film plasticizer agent (phthalates³); and (d) a volatile organic solvent (e.g., ethyl acetate, acetone, or ethanol⁴). Answer, bridging

¹ See Gleichenhangen, column 6, line 65 - column 7, line 2.

² See Gleichenhangen, column 4, lines 17-25.

³ See Gleichenhangen, column 1, lines 45-48.

⁴ See Gleichenhangen, column 1, lines 33-65.

paragraph, pages 3-4. The examiner finds, however, that Gleichenhagen differs from appellants' claimed invention by not teaching the same concentration of ingredients.

In addition, the examiner relies on Tipton to teach "that it is well known to incorporate [specific drugs] to [sic] a liquid bandage formulation. . . ." Answer, page 8. In this regard, the examiner finds that Tipton teach a liquid bandage formulation comprising tolnaftate, an antifungal agent. Answer, page 4. Similarly, the examiner relies on Modak to teach the physiologically active agents, centrimide, chlorbutanol and triclosan. Answer, page 5.

Based on the foregoing evidence, the examiner finds (Answer, page 5), "[i]t would have been obvious to one of ordinary skill at the time the invention was made to have modified the compositions of Gleichenhagen by the use of active agents such as tolnaftate, centrimide, chlorbutanol, or triclosan in order to benefit from the activities of such agents in topical wound dressings as taught by Tipton and/or Modak. While the examiner recognizes that concentrations for the ingredients taught by Gleichenhagen differ from appellant's concentrations⁵, the examiner finds "[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See In re Aller, 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A. 1955)."

In response, appellant asserts (Brief, pages 6-7), there is no doubt that Gleichenhagen addresses the use of plasticizers, e.g., softening agents such as

⁵ We find the same to be true of Tipton. See e.g., the polymer to solvent ratio at column 6, lines 35-41.

phthalates. See Gleichenhagen, column 1, lines 45-48. However, as appellant points out (Brief, page 7), Gleichenhagen mentions the use of plasticizers in the context of what was done in the art prior to Gleichenhagen's invention. We agree. See Gleichenhagen, column 1, lines 33-51. In this regard, we note that Gleichenhagen teach (column 3, lines 18-25), that dangers exist in the use of "softening agents." Therefore, Gleichenhagen specifically disclose that their invention intends to produce a film forming composition that does not contain "auxiliary agents, such as softening agents." See Gleichenhagen, column 3, lines 49-52. Accordingly, we find ourselves in agreement with appellant (Brief, page 7, emphasis removed) in that Gleichenhagen "teaches away from the use of a plasticizer."

We recognize the examiner's reliance on a number of pieces of case law, which allegedly supporting the examiner's position. See e.g., the examiner's reliance on In re Gurley, 27 F.3d 551,554, 31 USPQ2d 1 130,1132 (Fed. Cir. 1994), for the proposition that "[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." The problem, however, with the examiner's reliance on Gurley, is that the examiner has yet to establish a prima facie case of obviousness. The examiner's reliance on Gleichenhagen commingles background information (e.g., what was done prior to his invention) with what Gleichenhagen discloses as his invention. As discussed above, in doing so, the examiner disregards, what Gleichenhagen discloses to be the problems with the prior art compositions – e.g., Gleichenhagen's disclosure that

softening agents have disadvantages. By ignoring this disclosure the examiner finds that it would have been prima facie obvious to a person of ordinary skill in the art to combine the prior art softening agents with the composition that Gleichenhagen discloses to be his invention. The result of the examiner's assertion would be to create a composition that Gleichenhagen discloses should be avoided. In determining whether the claimed invention is obvious, a prior art reference must be read as a whole and consideration must be given where the reference teaches away from the claimed invention. Akzo N.V., Aramide Maatschappij v.o.f. v. United States Int'l Trade Comm'n, 808 F.2d 1471, 1481, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986). Accordingly, we are not persuaded by the examiner's arguments.

The examiner's reliance on Tipton and Modak for teaching physiologically active agents fails to make up for the deficiency in Gleichenhagen.

While the examiner points out (Answer, page 4) that in addition to teaching an antifungal agent, Tipton teaches a biodegradable film dressing comprising solvents, pore-forming agents and phthalic esters, the examiner fails to explain how these components of the two part dressing⁶ taught by Tipton can be used to modify the composition taught Gleichenhagen. In addition, to the extent that Tipton is relied upon alone, the examiner has failed to explain how

⁶ See e.g., Tipton, abstract, "[t]he film is formed by dispensing . . . the liquid composition onto a tissue site and contacting the liquid composition with an aqueous based fluid to coagulate or solidify the film onto the human or animal tissue."

Tipton's two part dressing relates to appellant's claimed invention which forms a film and consists essentially of the listed ingredients in a single composition. On the record before us, we find no reasonable suggestion for combining the teachings of the references relied upon by the examiner in a manner which would have led one of ordinary skill in this art to arrive at the claimed invention.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness." In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). In satisfying this initial burden, "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercer, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

For the foregoing reasons, it is our opinion that the examiner failed to provide the evidence necessary to establish a prima facie case of obviousness. Accordingly, we reverse the rejection of claims 22-32, 34, 37, and 38 under 35 U.S.C. § 103 as being unpatentable over the combination of Gleichenhangen, Tipton and Modak.

REVERSED

Carl E. Evans

Donald E. Adams
Administrative Patent Judge

Administrative Patent

Lora M. Green
Administrative Patent Judge

[Signature]

Richard M. Lebovitz
Administrative Patent Judge

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